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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,701	10/02/2003	Victor V. Levenson	NWESTERN-08390	9778
23535	7590	08/10/2007		
MEDLEN & CARROLL, LLP 101 HOWARD STREET SUITE 350 SAN FRANCISCO, CA 94105			EXAMINER GOLDBERG, JEANINE ANNE	
			ART UNIT 1634	PAPER NUMBER
			MAIL DATE 08/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/677,701

Applicant(s)

LEVENSON ET AL.

Examiner

Jeanine A. Goldberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 23-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-14 and 23-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Restriction Requirement

1. It is noted that the instant claims in the RCE have been amended to differ in scope from the elected subject matter of the claims in the previous round of prosecution. As noted in MPEP 706.07 (h), Applicants cannot file an RCE to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined as a matter of right (i.e., applicant cannot switch inventions). See 37 CFR 1.145.

In the response to restriction filed May 3, 2006, Applicants clearly elected a combination of 8 genes and amended the claims to more specifically point this out. Applicants have now amended their claims to broaden the scope to only 2 genes.

In an effort to facilitate applicant's prosecution of the application, the examiner will consider searching a new invention, however applicants must select a single invention for examination.

2. The claims (namely claims 3-14) are drawn to methods which require identifying the methylation status of DAPK and one of 7 other genes. The claims are directed to numerous distinct methods recited in the alternative. The language "at least one additional gene" requires that one, two, three or any number more up to the 7 recited genes are analyzed for methylation. For example, a method requiring DAPK and RIZ1 is distinct from a method requiring DAPK and MDR1 because the methods have a

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different mode of operation, do not overlap in scope, and they are not obvious variants of one another (see MPEP 806.05(j)).

The claims further encompass many subcombinations which are disclosed as usable together in a single combination and which are also separately usable. For example, consider the following combinations of "one or more" SNP selected from those disclosed in SEQ ID NO: 1-101:

Subcombination (A): DAPK and MDR1

Subcombination (B): DAPK and RIZ1

Combination (A+B): DAPK and MDR1 and RIZ1

Each of the combinations of genes are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In this case subcombinations (A) and (B) do not overlap in scope and there is no evidence on the record to suggest that they are obvious variants of one another. The subcombinations are separately usable as evidenced by their presentation in the alternative within the claims. Further, subcombination "A" has separate utility such as detecting the genes, as a marker, or for linkage studies, for examples. So, subcombinations (A) and (B) are distinct. See MPEP § 806.05(d).

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These subcombinations are also distinct from the combination which comprises them because the combination does not require the particulars of the subcombination as claimed to show novelty or unobviousness and the subcombinations have utility by themselves or in another combination. The fact that the claim encompasses an embodiment which relies on only subcombination (B) is evidence that the details of subcombination (A) are not required for patentability of the combination (A+B), and likewise, the fact that the claim encompasses an embodiment which relies on only subcombination (A) is evidence that the details of subcombination (B) are not required for patentability of subcombination (A+B). The fact that the claim encompasses embodiments which use only subcombination (A) or subcombination (B) is evidence that the subcombinations have utility by themselves.

This example particularly discusses only the combinations (A), (B) and (A+B), but the same analysis could be applied to each of the different subcombinations and combinations set forth in the instant claims.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Each gene must be searched by a separate query of the electronic databases. See MPEP 808.02(C). Therefore, a search for methods which use each gene or each combination of genes is not co-extensive with methods which use each other gene or each other combination of genes, and subsequently, the search and examination for

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every gene and every combination of genes poses an enormous and serious burden on the examiner.

Applicant is required to select a single invention. The invention may be DAPK and a single gene, a combination of DAPK and more than one gene but less than all of the disclosed genes or a combination of all possible claimed genes. However, an election of a single invention, ie, a single combination of genes is required. This restriction requirement is predicated on the fact that the methods which use different genes or different combinations of genes do not appear obvious over one another. Should applicant traverse on the ground that the different genes or different combinations of genes are not patentably distinct over each other, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variant over each other or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other inventions.

Applicant is also required to identify which claims read upon the elected invention.

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a

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continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Burden

3. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

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Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Joint Inventors

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4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeanine Goldberg whose telephone number is (571) 272-0743. The examiner can normally be reached Monday-Friday from 7:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571) 272-0735.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Central Fax Number for official correspondence is (571) 273-8300.


Jeanine Goldberg
Primary Examiner
August 6, 2007